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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/931,590	08/16/2001	Scott G. Newnam	109.779.134	2417
23483	7590	05/16/2005	EXAMINER	
WILMER CUTLER PICKERING HALE AND DORR LLP 60 STATE STREET BOSTON, MA 02109				ALAM, UZMA
ART UNIT		PAPER NUMBER		
2157				

DATE MAILED: 05/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/931,590	NEWNAM ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Uzma Alam	2157	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 03 March 2005.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-27 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

This action is responsive to the application filed on March 3, 2005. Claims 1-27 are pending. Claims 20-27 are new. Claims 1-27 represent an interactive storage device storing broadcasted events.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3-9, 11-13, and 15-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Harper et al. US Patent No. 5,537,141. Harper discloses the invention as claimed including an interactive distance learning system (see abstract).

As per claims 1 and 13, Harper discloses a method and system for enhancing content during a broadcast event for remote viewers having a local storage device for storing the broadcast event and playing back the broadcast event, the method comprising:

the local storage device storing the broadcast event (column 3, lines 59-67; column 4, lines 1-12; column 5, lines 7-37; column 7, lines 11-24; column 18, lines 23-55);  
a personal interactivity recorder (PIR) storing interactive content provided from a server system and related to the broadcast event and temporally associating the interactive content with

the broadcast event (an interactive device storing broadcasted events; column 3, lines 34-67; column 4, lines 1-12; column 5, lines 7-37; column 6, lines 42-57; column 19, lines 21-29);

when the broadcast event is played back from storage, the PIR providing to the user the interactive content during times within the stored broadcast event when such content would have been displayed when the event was broadcast (storing interactive responses; column 4, lines 11-57; column 5, lines 46-63; column 11, lines 36-63; column 11, lines 36-63; column 19, lines 55-67; column 20, lines 1-22).

As per claims 3 and 15, Harper discloses the method and system of claims 1 and 13, wherein the temporal associating includes using one or more of absolute time codes, relative time codes, and frame sequence numbers (the broadcast event is played back using relative sequencing; column 6, lines 20-41; column 7, lines 11-64; column 12, lines 1-25).

As per claims 4 and 16 and 17, Harper discloses the method and system of claims 1 and 13 wherein the interactive content includes trivia questions, the user has an input device for entering an answer, and the PIR stores the correct answer and provides to the user an indication of a correct or incorrect answer after the user enters an answer to a question (the event stores answers to questions during the broadcast; column 6, lines 58-67; column 7, lines 1-10).

As per claims 5 and 18, Harper discloses the method of claims 1 and 13, wherein the interactive content includes poll questions, the PIR storing poll results, the user has an input

device for entering a response, and the PIR provides poll results after the user enters a response to the poll question (column 25, lines 18-67; column 26, lines 13-20).

As per claims 6 and 19, Harper discloses the method of claim 1, wherein the interactive content and video broadcast event are stored on the same medium (column 7, lines 11-24; column 6, lines 45-49; column 17, lines 53-67; column 18, lines 1-22, 43-67; column 19, lines 1-20).

As per claim 7, Harper discloses the method of claim 1, wherein the PIR uses the processing and storing functionality of the local storage device (column 7, lines 11-24; column 6, lines 45-49; column 17, lines 53-67; column 18, lines 1-22, 43-67; column 19, lines 1-20).

As per claim 8, Harper discloses the method of claim 7, wherein the local storage device includes a hard drive (column 7, lines 11-24; column 6, lines 45-49; column 17, lines 53-67; column 18, lines 1-22, 43-67; column 19, lines 1-20).

As per claim 9, Harper discloses the method of claim 1, wherein the local storage device includes a hard drive (column 7, lines 11-24; column 6, lines 45-49; column 17, lines 53-67; column 18, lines 1-22, 43-67; column 19, lines 1-20).

As per claim 11, Harper discloses the method of claim 1, where in the broadcast event and interactive content are sent over different channels of transmission (column 9, lines 36-55; column 14, lines 46-52; column 16, lines 16-44).

As per claim 12, Harper discloses the method of claim 1, wherein the PIR includes processing and storage (column 7, lines 11-24; column 6, lines 45-49).

As per claims 20 and 24, Harper discloses the method and system of claims 1 and 13, wherein the broadcast is received from a head-end facility separate from the server system (column 9, lines 56-67; column 10, lines 1-21).

As per claims 21 and 25, Harper discloses the method and system of claims 1 and 13, wherein, during playback, the server system interacts with the user such that the user receives responses from the server in response to input from the user (column 19, lines 21-42).

As per claims 22 and 26, Harper discloses the method of claims 21 and 25, wherein the user receives a prompt to enter a poll response and the server system is responsive to the poll response when the poll response is entered at a time other than during the line broadcast (column 11, lines 36-61).

As per claims 23 and 7, Harper discloses the method of claims 1 and 13, wherein the PIR receives programming by downloading or flashing (column 17, lines 33-67; column 18, lines 9-67).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harper et al. in view of Dunn et al. US Patent No. 5,517,257. Harper discloses the method and system of claims 1 and 13 including the PIR having the functionality of a VCR and set top box. See claims 1 and 13 and column 7, lines 11-24; column 16, lines 45-49; column 47, lines 36-52. Harper does not expressly disclose wherein the local storage device includes functionality for fast forward, rewind, and pause functions. Dunn discloses the local storage device includes functionality for fast forward, rewind, and pause functions. See column 5, lines 39-60. However, the concept and advantages of fast forward, rewind and pause functions is old and well known in the art. It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify the VCR and set top box function of Harper with fast forward, rewind and pause functions. A person of ordinary skill in the art would have been motivated to do this to allow the user to view the event conveniently.

Claim 10 is rejected under 35 U.S.C. 103(a) as being anticipated by Harper et al. US Patent No. 5,537,141 in view of Bolnick et al. US Patent Publication No. 2002/0023230.

Harper discloses the method of claim 1. Harper does not disclose wherein the PIR stores and plays back messages sent by other viewers using a chat functionality during the broadcast event. Bolnick discloses wherein the PIR stores and plays back messages sent by other viewers using a chat functionality during the broadcast event. See paragraph 0034 and claim 12. It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine the chat functionality of Bolnick with the broadcast event of Harper. A person of ordinary skill in the art would have been motivated to do this to enhance the interactivity of the session.

#### *Response to Arguments*

1. Applicant's arguments filed March 3, 2005 have been fully considered but they are not persuasive.
2. Applicant arguments are 1)the reference does not teach associating a broadcast event with interactive content provided from a server 2) the reference does not teach that the broadcast is temporally associated with the interactive content and 3) that a chat functionality interferes with the a one-on-one relationship of the student and the teacher.

In response, Harper does show that the interactive content is associated with the broadcast event. In Harper, the student is watching a broadcast of a teacher lecture. Periodically in the lecture, there are questions that the student needs to answer. The student answers the

question, and based on the response, he gets feedback from the teacher as if the teacher they were in a real classroom setting. The lecture can be broadcast live or can be viewed anytime after the recording (column 11, lines 43-63)

When the student gives a response, there is a teacher response that correlates to the student response. When the student enters a response, this specific teacher response is inserted, using frame and time references, into the broadcast that the student is watching. See column 12, line 9-25; column 16, lines 63-67; column 18, lines 26-32; column 20, lines 10-59.

Because the responses are only inserted in a specific time period and for short amount of times, this shows that the response to the interactive question is associated with the broadcast lecture temporally. See column 5, lines 34-67, column 6, lines 1-19column 12, line 9-25; column 16, lines 63-67; column 18, lines 26-32; column 20, lines 10-59.

In response that a one-on-one relationship teaches away from chat functionality, Examiner respectfully disagrees. A chat function between two parties would significantly enhance the quality of the session and would individualize the type of feedback a student is receiving, which would give the student greater benefit. See column 4, lines 35-39 and column 6, lines 19-28.

### *Conclusion*

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

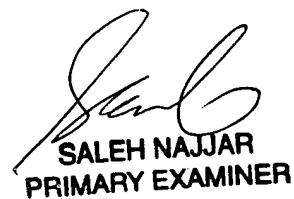
MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Uzma Alam whose telephone number is (571) 272-3995. The examiner can normally be reached on Monday-Tuesday 9 AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571) 272-4001. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Uzma Alam



SALEH NAJJAR  
PRIMARY EXAMINER